

### REMARKS

Claims 6, 17, 23, 29 and 40-71 are pending in this application.

Applicant has amended claims 6, 17, 23, 29, 52, 57, 62 and 67. Support for the amendments to the claims can be found, for example, in the Specification at p. 19-22. No new matter has been introduced.

Claims 6, 7, 23, 29, 40-42, 44-46, 48-50, 52-55, 57-60, 62-65 and 67-70 have been rejected under 35 U.S.C. 103(a) as unpatentable over the Foadare et al. patent (US 6,311,210 B1) in view of the Redpath patent (US 6,256,672 B1), and further in view of the Beck et al. patent (US 5,903,723). Claims 43, 47, 51, 56, 61, 66 and 71 have been rejected as unpatentable over these references further in view of the Ulrich et al. patent (US 6,052,735).

Applicant respectfully traverses these rejections in view of the above amendments and the following remarks.

#### Receiver's Side Control of Sending E-Mails with or without Attachment

Amended claim 6 recites an article with a machine-readable medium storing machine-readable instruction. A sender is enabled to append an attachment to a message and to designate at least one recipient to receive the message and the attachment, and to designate at least one recipient to receive the message without the attachment. A recipient is enabled to create and edit a reception profile, which includes the recipient's preferences with regard to receipt of prospective attachments. The message is transmitted over a network from the sender to the recipients.

For any recipient whose reception profile specifies not to receive an attachment, the message is transmitted to the recipient from the sender without the attachment regardless of whether the sender designated the recipient to receive the message with or without the attachment.

For any recipient whose reception profile specifies to receive an attachment, the message is transmitted to the recipient from the sender with the attachment, if the sender designated the recipient to receive the message with the attachment

Thus, the reception profile prevents transmitting an attachment to a recipient who has specified not to receive an attachment. However, the reception profile does not prevent transmitting an email with an attachment if a) the sender designated the recipient to receive the attachment and b) the reception profile specifies the recipient to receive such an attachment.

The amendment clarifies that the reception profile impacts the transmission process, *i.e.*, whether an email will be sent with or without the attachment. Thereby, the network is loaded with the transmission of the attachment only if the reception profile is specified accordingly.

The combination of the Foladare et al. patent, the Redpath patent, and the Beck et al. patent does not render obvious the subject matter of claim 6.

The cited references do not disclose or suggest any control mechanism that provides for the receiver's side to control actions on the sender's side, such as the decision to add or not add an attachment to an email. The cited references disclose only attachment-related processes that take place exclusively on the receiver's side (Foladare et al.) or on the sender's side (Redpath and Beck et al.). That is, Foladare et al. allow only for the receiver side to control the receiver side decisions, and Redpath and Beck et al. allow only for the sender side to control the sender side decisions. However, the reception profile (which is defined on the receiver's side) as recited in claim 6 has impact on or controls decisions on the sender's side. Thus, the method of claim 6 is significantly different from the cited references.

For the receiver's side, the Foladare et al. patent discloses a centralized electronic mail apparatus that delivers a previously transmitted email to a variety of electronic mail receiving devices. However, the email message was previously sent from a sending party, and the act of sending the message was not impacted in any way by the centralized electronic mail apparatus. Thus, the decision to send the email message with or without an attachment was previously done on the sender's side.

When a sending party wishes to send an electronic mail message to a receiving party, the sending party creates the electronic mail message along with any attachments using his/her user device and sends the electronic mail message to the centralized electronic mail apparatus. The centralized electronic mail apparatus receives the electronic mail message and retrieves profile information...

The centralized electronic mail apparatus then sends the portions of the electronic mail message to the electronic mail receiving devices ...(col. 1, ll. 36-53)

On the receiver's side, a profile database is used in a way that, for example, "only those portions of the electronic mail message, which the receiving party deems the most important by identifying them in the profile database 165, are sent to the electronic mail receiving device 120-150." (See col. 1, ll. 36-55 and col. 6, ll. 11-15.)

The centralized electronic mail apparatus processes emails that previously were sent (with or without an attachment). The centralized electronic mail apparatus, therefore, does not impact how email messages are sent from the sender. Specifically, it does not impact whether the email message is sent from the sender with or without the attachment.

Essentially, the mail apparatus of Foadare et al. decides whether or not to forward an already sent email to various receiving devices and, further, whether the already sent email should be sent to a particular receiving device with or without an attachment depending on whether the particular receiving device is suited to receive the attachment (col 3, lines 36-54; col 6, lines 18-40). For example, an already sent email may be routed to a person's PDA without the attachment, while the email with the attachment may be routed to the person's personal computer. Obviously, the mail apparatus of Foadare et al. does not impact whether or not the email was sent with or without an attachment from the sender's side. And, Foadare et al. clearly does not recognize the issue of controlling sender side action by the receiver side.

Therefore, the Foladare et al. patent does not disclose a reception profile that impacts the sending of an email with or without attachments as recited in claim 6.

Specifically, the Foladare et al. patent does not disclose transmitting the message over a network "from the sender to the plurality of recipients, wherein the message is transmitted from the sender without the attachment to any recipient whose reception profile specifies not to receive an attachment, regardless of whether the sender designated the recipient to receive the message with or without the attachment, and wherein if the sender designated the recipient to receive the message with the attachment, the message is transmitted from the sender with the attachment to any recipient whose reception profile specifies to receive an attachment."

The Office action relies on the Redpath patent for its disclosure of a "sender designating a recipient to receive the message without the attachment."

For the sender's side, the Redpath patent discloses a new addressee line identifier that allows an e-mail sender to notify additional addressees of what has been sent to the primary addressee without slowing down transmission time or wasting storage space by including unneeded and possibly quite large attachment files (abstract). Instead, an attachment icon is sent to indicate an attachment has been sent to another user. Thus, the sender alone determines the sending process.

The Office action further alleges that one of ordinary skill in the art would modify the centralized electronic mail apparatus of the Foladare et al. patent on the sender side. However, such a combined system would not result in the claimed subject matter. Instead, in such a combined system, the decision to send, i.e., transmit, an email message with or without an attachment would still be controlled on the sender's side only, whereas on the recipient's side, the centralized electronic mail apparatus would decide whether an email message transmitted by the sender with the attachment is delivered with or without the attachment to different electronic mail receiving devices according to the profile database.

In addition, the Office action relies on the Beck et al. patent for its disclosure that "the message is transmitted from the sender without the attachment."

The Beck et al. patent discloses a method for transmitting email attachments by replacing the attachment on the sender's side with an attachment reference (col. 5, lines 3-5). Thus, instead of transmitting the attachment, a reference is transmitted and the attachment is stored locally. On the recipient's side, a user can later access the attachment from a recipient PC via the attachment reference (*see* col. 5, lines 39-53).

By sending an attachment reference, the Beck et al. patent is similar to the Redpath patent, which sends an attachment icon to indicate an attachment has been sent to another user. However, the attachment reference of the Beck et al. patent provides the additional feature that the stored attachment can be accessed.

In the Redpath and the Beck et al. references, the replacement of the attachment (with an icon or an attachment reference) is based solely on activity on the sender's side.

Thus, the Redpath patent and the Beck et al. patent do not disclose that the transmission of an attachment from the sender to a recipient is impacted by a "reception profile." A combined system would replace an attachment either with the "attachment icon" (Redpath patent) or with the "attachment reference" (Beck et al. patent). The replacement of any attachment would be initiated based solely on the sender's side independently of any action at the recipient's side.

In view of the forgoing comments and the claim amendments, Applicant respectfully requests that the Examiner withdraws the rejection of claim 6.

At least for the foregoing reasons, claim 6 and its dependent claims should be allowed. Claims 17, 23, 29, 52, 57, 62 and 67 recite similar features. Those claims, as well as their dependent claims, also should be allowed for the same reasons.

#### Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or

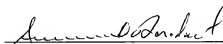
concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In view of the foregoing remarks, all pending claims are believed to be allowable and a notice of allowance is requested.

The fee for the Three Month Extension of Time of \$1050.00 is being filed concurrently with the Electronic Filing System (EFS) by way of Deposit Account authorization. Please charge all charges or credits to deposit account 06 1050, referencing Attorney Docket No. 21175-002001.

Respectfully submitted,

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